

REMARKS

Applicant is alarmed that yet another rejection is issued which is based on a totally erroneous application of the *Adamson* reference.

Claims 1, 6, 8, 9, 13, 14 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Porzilli* in view of *Adamson*. Claims 2-5, 7, 10-12, 17, 15 and 17-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Porzilli* and *Adamson* in view of *Mitchell*. Applicant traverses these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Each of the independent claims 1, 9 and 17 calls for:

"an acoustic box connected to the speaker, the box having a sound reflecting distal wall including a plurality of stepped portions, each stepped portion being of a different distance from the speaker than each other stepped portion, and each stepped portion being substantially parallel to each other stepped portion and to the speaker."

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

There is no teaching, incentive or motivation in the references for providing the claimed combination which is clearly described in the application.

Applicant claims a specific structure for a sound reflecting distal wall.

Adamson has no such structure and in fact teaches away from such a structure. *Adamson* clearly states, in reference to Figs. 3 and 4, at col. 10, lines 30-39: "The mid frequency magnet 19 is constructed with an opening at its center 20 to allow the passage of high frequency sound waves through the mid frequency magnet and into entrance 21 of the high frequency sound chamber 16. The mid frequency phase plug body 22 and the phase plug ring 23 are so constructed to guide the mid frequency sound wave generated by the mid frequency diaphragm 24 into the entrance or input orifice 25 of the mid frequency sound chamber 28 **without acoustical interference caused by reflecting sound waves.**"

Thus, *Adamson* has no sound reflecting distal wall as claimed and therefore can not have the specific structure of the wall as claimed. *Adamson* clearly states: "**without acoustical interference caused by reflecting sound waves**" at lines 38-39."

Withdrawal of the rejections is therefore requested.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither references teach or even suggest the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO " failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the

claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1, 9 and 17 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-24 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


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